

REMARKS

Claim 12 the only pending claim, has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the disclosed embodiments. Applicants submit that the present Amendment does not generate any matter issue.

Claim 12 was rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Todorobaru et al.

In the statement of the rejection, the Examiner referred to Figs. 3 through 23, asserting the disclosure of a method corresponding to that claimed, including the manipulative steps of forming first metal silicide layer 35A, forming plug electrode 25 and forming second metal silicide layer 35B. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Elan Pharmaceuticals Inc. v. Mayo Foundation*, ___ F.3d ___, 64 USPQ2d 1292 (Fed. Cir. 2002); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. cir. 2002). There is a fundamental difference between the claimed method and the methodology disclosed by Todorobaru et al. that scotches the factual determination that Todorobaru et al. disclose a method identically corresponding to that claimed.

Specifically, even before the present Amendment which only clarifies what one having ordinary skill in the art would have understood, the recited manipulative steps are preformed sequentially. This is the only reasonable interpretation of the claimed method, even before the present Amendment, which is consistent with the written description of the specification. *In re Cortright*, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999); *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Thus, the present Amendment does not generate any new issue.

In contradistinction to the present Amendment, in accordance with the teachings of Todorobaru et al., metal silicides 35A and 35B must be formed in a single manipulative step. Not so in accordance with the claimed method wherein the first and second metal silicides are formed through different manipulative steps at different points in the process.

The above argued difference in manipulative steps between the claimed method and the methodology of Todorobaru et al. undermines the factual determination that Todorobaru et al. disclose a method identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claim 12 under 35 U.S.C. §102 for lack of novelty as evidenced by Todorobaru et al. is not factually viable and, hence, solicit withdrawal thereof.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AJS:ntb
Facsimile: (202) 756-8087
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